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EXAMINER

PEDDER, DENNIS H

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* SCOTT CLARE and NEIL G. LONG
9

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11 Appeal 2008-0339
12 Application 09/083,422
13 Technology Center 3600
14

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16 Decided: May 16, 2008
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18

19 *Before* WILLIAM F. PATE, III, MURRIEL E. CRAWFORD and JOSEPH
20 A. FISCHETTI, *Administrative Patent Judges*.

21
22 PATE, III, *Administrative Patent Judge*.

23
24 DECISION ON APPEAL
25

26 STATEMENT OF CASE

27 The Appellants appeal under 35 U.S.C. § 134 (2002) from a Final
28 Rejection of claims 49-56, 58-62, 64-73, 85, 86, 88, 89, 91, 92, 98, 99, 101,
29 105, 106, 108, 109, 111 and 113. Claims 94, 96, 97, 126 and 127 have been
30 allowed and claims 57, 74 and 87 have been indicated to be allowable if

1rewritten in independent form. All remaining claims have been previously
2canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

3 The Appellants claim a storage system for a vehicle that is accessible
4through an exterior side panel of the vehicle.

5 Independent claim 49 reads as follows:

6 49. A storage system for a vehicle having a driver
7 compartment and a passenger compartment rearward of the
8 driver compartment and within a single enclosure, wherein the
9 enclosure is defined by a floor, a roof, two opposing side walls
10 which each connect the roof to the floor, and exterior side
11 panels, wherein the passenger compartment includes opposing
12 rear wheel wells extending into the passenger compartment
13 from the bottom edges of the side panels,
14 the storage system comprising at least one storage area
15 adjacent to and separated from the passenger compartment, the
16 storage area being defined by at least a portion of an exterior
17 side panel, an inner panel, a top and bottom which connect the
18 inner panel to the exterior side panel, and wherein the storage
19 area extends into the passenger compartment no further than the
20 wheel well extends into the passenger compartment,
21 wherein at least one section of the exterior side panel is
22 hinged to provide access to the storage area therein.
23

24 Independent claim 61 recites a similar storage area in a vehicle having
25forward and rear compartments, the separation width and cross sectional
26contour of the side panels of the enclosure being substantially the same as
27the separation width and cross sectional contour of the forward
28compartment.

29 Independent claim 85 also recites a similar storage area in a vehicle
30with at least two rows of seats where the width of the storage area is not

1greater than the width of the wheel well, and the storage area includes a latch
2and a strut for retaining the hinged section in the open position.

3 The prior art relied upon by the Examiner in rejecting the claims is:

4Hawkins	2,159, 022	May 23, 1939
5Stahl	2,192,207	Oct. 13, 1937
6Sparling	4,315,653	Feb. 16, 1982
7Gallagher	5,709,309	Jan. 20, 1998
8Powers	Des. 143,990	Apr. 28, 1945
9Hamel	Des. 230,351	Feb. 12, 1974

10 The Examiner rejected claims 49-55, 58, 60, 98, 99, 101, 106, 108 and
11109 under 35 U.S.C. § 103(a) as unpatentable over Sparling in view of
12Hawkins and Stahl¹.

13 The Examiner rejected claims 61, 62, 64-68, 70-72, 111 and 113
14under 35 U.S.C. § 103(a) as unpatentable over Stahl in view of Hawkins.

15 The Examiner rejected claims 85, 86, 89, 91 and 92 under 35 U.S.C.
16§ 103(a) as unpatentable over Stahl or Sparling in view of Hawkins and
17Hamel.

18 The Examiner rejected claims 56 and 73 under 35 U.S.C. § 103(a) as
19unpatentable over Sparling or Stahl in view of Hawkins and Hamel.

10¹ The Examiner cites Stahl in this rejection for the first time in the
11Examiner's Answer (Ans. 3). The Appellants note that this is a new ground
12of rejection but request the appeal be maintained (Reply Br. 3).

1 The Examiner rejected claims 59 and 88 under 35 U.S.C. § 103(a) as
2unpatentable over Sparling or Stahl in view of Hawkins, optionally in view
3of Hamel, and further in view of Gallagher et al.

4 The Examiner rejected claims 69 and 73 under 35 U.S.C. § 103(a) as
5unpatentable over Stahl in view of Hawkins and Hamel.

6 The Examiner rejected claim 105 under 35 U.S.C. § 103(a) as
7unpatentable over Sparling in view of Hawkins and Powers.

8 We AFFIRM.

9

10 ISSUES

11 The following issues have been raised in the present appeal.

12 1. Whether the Appellants have shown that the Examiner erred in
13rejecting claims 49-55, 58, 60, 98, 99, 101, 106, 108 and 109 as unpatentable
14over Sparling in view of Hawkins and Stahl.

15 2. Whether the Appellants have shown that the Examiner erred in
16rejecting claims 61, 62, 64-68, 70-72, 111 and 113 as unpatentable over
17Stahl in view of Hawkins.

18 3. Whether the Appellants have shown that the Examiner erred in
19rejecting claims 85, 86, 89, 91 and 92 as unpatentable over Stahl or Sparling
20in view of Hawkins and Hamel.

21 4. Whether the Appellants have shown that the Examiner erred in
22rejecting claims 56 and 73 as unpatentable over Sparling or Stahl in view of
23Hawkins and Hamel.

1the wheel well (Fig. 4). Hawkins further specifically teaches that such a
2truck allows carrying of a large variety of tools and equipment while
3facilitating access to the tools and increasing the carrying capacity of the
4truck (Pg. 1, Col. 1, ll. 8-13).

5 3. Stahl discloses a vehicle having a driver compartment and a
6passenger compartment rearward of the driver compartment that is within a
7single enclosure (Figs. 1 and 4; Pg. 1, Col. 2, l. 45-Pg. 2, Col. 1, l. 2). Stahl
8also discloses a storage system comprising a storage area adjacent to, and
9separated from, the passenger compartment, the storage area extending into
10the passenger compartment (Figs. 1-4; Pg. 2, Col. 1, ll. 25-54). Stahl teaches
11the desirability for providing within the vehicle, a seating arrangement for
12numerous men as well as adequate storage space (Figs. 1-4; Pg. 1, Col. 1, ll.
137-44). The separation width and cross sectional contour of the side panels of
14the enclosure in Stahl is substantially the same as the separation width and
15cross sectional contour of the forward compartment where it adjoins the side
16panels (Figs. 4 and 5).

17 4. Hamel discloses a vehicle including at least one hinged section
18in the exterior surface of a side panel, at least one storage area located
19adjacent the hinged section, a latch for retaining the hinged section in the
20closed position, and a strut for retaining the hinged section in the open
21position (Figs. 1 and 4).

22 5. Powers discloses a vehicle having a storage area defined by a
23portion of an exterior side panel that is hinged, the width of the storage area
24being approximately the same as the width of the wheel well (Figs. 1-5).

1 PRINCIPLES OF LAW

2 “Section 103 forbids issuance of a patent when ‘the differences
3between the subject matter sought to be patented and the prior art are such
4that the subject matter as a whole would have been obvious at the time the
5invention was made to a person having ordinary skill in the art to which said
6subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727,
71734 (2007). The question of obviousness is resolved on the basis of
8underlying factual determinations including (1) the scope and content of the
9prior art, (2) any differences between the claimed subject matter and the
10prior art, (3) the level of skill in the art, and (4) where in evidence, so-called
11secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18
12(1966). In *KSR*, the Supreme Court reaffirmed principles based on its
13precedent that “[t]he combination of familiar elements according to known
14methods is likely to be obvious when it does no more than yield predictable
15results.” *KSR*, 127 S.Ct. at 1739. The Court also explained that “[w]hen a
16work is available in one field of endeavor, design incentives and other
17market forces can prompt variations of it” and that “[i]f a person of ordinary
18skill can implement a predictable variation, §103 likely bars its
19patentability.” *Id.* at 1740. The Court noted that “[t]o facilitate review, this
20analysis should be made explicit,” but “the analysis need not seek out
21precise teachings directed to the specific subject matter of the challenged
22claim” *Id.* at 1741, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

23

1 ANALYSIS

2 Claims 49-55, 58, 60, 98, 99, 101, 106, 108 and 109

3 The Examiner rejected these claims as unpatentable over Sparling,
4Hawkins and Stahl (Ans. 3). The Appellants argue these claims as a group
5(App. Br. 4-6). Thus, we select independent claim 49 to decide the appeal
6with respect to this group of claims, claims 50-55, 58, 60, 98, 99, 101, 106,
7108 and 109 standing or falling with claim 49. *See* 37 C.F.R. § 41.37(c)(1)
8(vii) (2007).

9 The Appellants argue that the vehicles of Hawkins and Stahl are
10commercial utility trucks and should not be combined with Sparling which
11is a pick-up truck with a camper top that does not disclose any storage
12system or problems associated thereto (App. Br. 5 and 6; Reply Br. 4).
13Thus, the Appellants argue that the Examiner has failed to establish *a prima*
14*facie* case of obviousness because the Examiner has not identified any
15suggestion to combine the references within the references themselves and
16has also failed to provide an objective reason for combining the references
17(App. Br. 5). The Appellants further argue that the vehicle of Sparling also
18cannot be combined with the storage systems of Hawkins because such a
19combination would destroy the additional passenger seating function of
20Sparling (App. Br. 10).

21 However, we note that the Examiner is not required to seek out
22precise teachings directed to the specific subject matter of the claim. *KSR*,
23127 S.Ct. at 1741. We also disagree with the Appellants contention that the
24applicable prior art is limited to non-commercial vehicles. Hawkins teaches

1the desirability of providing storage area in a vehicle that is accessed from
2the exterior side panel for carrying tools and equipment, for facilitating
3access to such tools, and for increasing the carrying capacity of the truck (FF
42). Stahl similarly teaches the desirability for providing a seating
5arrangement for numerous men and adequate storage space in a vehicle that
6includes a storage area accessible from the exterior side panel (FF 3).

7 In contrast to the Appellants' assertion that the Examiner has not
8articulated a motivation to combine these references, the Examiner stated
9that "it would have been obvious to one of ordinary skill to provide in
10Sparling a storage compartment . . . in order to store tools, spare parts, etc.
11away from the passenger compartment" (Final Office Action 2). Thus, the
12Examiner has articulated a rational reason for providing the storage
13compartment of Hawkins in the vehicle of Sparling based on the teachings
14of Hawkins. Similar analysis applies with respect to Stahl which teaches the
15desirability of adequate storage space and seating (FF 3). With respect to
16the Appellants' argument that the passenger seating function of Sparling
17would be destroyed, we note that the storage area in the vehicle of Stahl is
18provided without destroying the passenger seating function thereof (Stahl:
19Figs. 1, 3 and 4).

20 In view of the above, we agree with the Examiner that independent
21claim 49 is unpatentable over Sparling in view of Hawkins and Stahl. Thus,
22we find that the Appellants have failed to show that the Examiner erred in
23rejecting claims 49-55, 58, 60, 98, 99, 101, 106, 108 and 109 as
24unpatentable.

1

2 Claims 61, 62, 64-68, 70-72, 111 and 113

3 The Appellants argue these claims as a group (App. Br. 6 and 7).

4Thus, we select independent claim 61 to decide the appeal with respect to
5this group of claims, claims 62, 64-68, 70-72, 111 and 113 standing or
6falling with claim 61. *See* 37 C.F.R. § 41.37(c)(1)(vii).

7 The Appellants traverse this rejection asserting that Stahl cannot be
8properly combined with Hawkins, that the Examiner has failed to establish
9motivation for combining these references, and that the combination still
10fails to result in the invention claimed (App. Br. 6). The Appellants argue
11that Stahl is a utility truck where the storage area is separated from the driver
12and passenger compartments by partition 8 (App. Br. 6). Thus, the
13Appellants assert that combining the storage system of Hawkins with the
14vehicle of Stahl does not result in limiting the storage to a width not greater
15than the wheel well and that the Examiner has failed to establish a *prima*
16*facie* case of obviousness (App. Br. 6 and 7).

17 The Appellants' arguments are not persuasive because Stahl discloses
18side members 11 with storage spaces and doors 12 that permit access to the
19storage spaces from the exterior of the vehicle (Pg. 2, Col. 2, ll. 25-31). It is
20these storage spaces to which the Examiner applies the teachings of
21Hawkins, not the compartment defined by the partition 8 (Final Office
22Action 4). As can be clearly seen by the cross sectional view of Figure 4,
23the storage area of Hawkins extends into the enclosure less than the wheel
24well (FF 2). The Examiner has further articulated that it would have been

1obvious to one of ordinary skill in the art to extend the storage spaces of
2Stahl into the enclosure less than the wheel well as shown in Hawkins so as
3to maximize the interior space of the larger compartment that is defined by
4the partition (Final Office Action 4). The Examiner's articulated rationale is
5reasonable in view of the competing interest in providing the maximum
6interior space of the larger compartment defined by the partition while also
7providing a usable storage space that is accessible from the exterior of the
8vehicle.

9 Therefore, in view of the above, we agree with the Examiner that
10independent claim 61 is unpatentable over Stahl in view of Hawkins. Thus,
11we find that the Appellants have failed to show that the Examiner erred in
12rejecting claims 61, 62, 64-68, 70-72, 111 and 113 as unpatentable.

13

14 Claims 85, 86, 89, 91 and 92

15 The Examiner rejected these claims as unpatentable over Sparling or
16Stahl in view of Hawkins and Hamel (Final Office Action 4). The
17Appellants argue these claims as a group (App. Br. 7 and 8). Thus, we select
18independent claim 85 to decide the appeal with respect to this group of
19claims, claims 86, 89, 91 and 92 standing or falling with claim 85. *See* 37
20C.F.R. § 41.37(c)(1)(vii).

21 The Appellants argue that the Examiner failed to establish
22motivation for combining Sparling or Stahl with Hawkins, and also failed to
23establish a motivation for combining Hamel as well (App. Br. 7). With
24respect to the combination of Sparling or Stahl with Hawkins, we disagree

1with the Appellants for the same reason discussed *supra* regarding the
2rejection of independent claim 49. Moreover, the Examiner stated that it
3would have been “obvious to hinge the side panel section at top and support
4with strut as taught by Hamel as a shelter from rain, for example” (Final
5Office Action 4). Hence, in contrast to the Appellants’ assertion, the
6Examiner has articulated a reason with a rational basis as to why one of
7ordinary skill in the art would utilize the strut for supporting the side panel
8section in the manner disclosed in Hamel.

9 Therefore, in view of the above, we agree with the Examiner that
10independent claim 85 is unpatentable over Sparling or Stahl in view of
11Hawkins and Hamel. Thus, we find that the Appellants have failed to show
12that the Examiner erred in rejecting claims 85-86, 89, 91 and 92 as
13unpatentable.

14

15 Claims 56 and 73

16 These claims ultimately depend from independent claims 49 and 61,
17respectively, and are directed to the inclusion of at least one strut assembly
18for retaining the hinged section of the side panel in an open position. These
19claims stand rejected as unpatentable over Sparling or Stahl in view of
20Hawkins and Hamel (Final Office Action 5). The Appellants contend that
21this rejection is improper and has been “previously addressed”, presumably
22in the arguments against the rejection of independent claim 85 which also
23recites such a strut (App. Br. 8). However, we disagree with the Appellants
24for the same reason discussed *supra* relative to claim 85. Therefore, the

1Appellants have not shown that the Examiner erred in rejecting claims 56
2and 73 as unpatentable.

3

4 Claims 59 and 88

5 These claims stand rejected as unpatentable over Sparling or Stahl in
6view of Hawkins, optionally in view of Hamel, and further in view of
7Gallagher (Final Office Action 5). The Appellants merely rely on
8previously discussed arguments asserting that motivation for combining
9Sparling, Stahl, Hawkins and/or Hamel has not been established, and further
10argue that Gallagher does not remedy this deficiency (App. Br. 8).
11However, we disagree with the Appellants for the reason discussed *supra*
12relative to independent claims 49 and 85. Therefore, the Appellants have
13not shown that the Examiner erred in rejecting claims 59 and 88.

14

15 Claims 69 and 73

16 Claim 69 relates to positioning of the hinged section while claim 73
17relates to a strut assembly. The Examiner rejected these claims as
18unpatentable over Stahl in view of Hawkins and further in view of Hamel
19(Final Office Action 5). The Appellants merely rely on previously discussed
20arguments asserting that motivation for combining Stahl, Hawkins and
21Hamel has not been established (App. Br. 9). However, we disagree with
22the Appellants for the reason discussed *supra* and find that the Appellants
23have not shown that the Examiner erred in rejecting claims 69 and 73.

24

1 Claim 105

2 Claim 105 which recites that the width of the storage area is
3approximately the same as the width of the wheel well stands rejected as
4unpatentable over Sparling in view of Hawkins and Powers (Final Office
5Action 5). The Appellants contend that claim 105 is not directed to a
6vehicle with modified wheel wells and that the Examiner has not established
7motivation to combine Sparling and Hawkins (App. Br. 9; Reply Br. 6).

8 We again agree with the Examiner that Sparling and Hawkins can be
9properly combined as discussed *supra* relative to the Examiner's rejection of
10independent claim 49 from which claim 105 ultimately depends. In
11addition, the basis of the Appellants' argument regarding the wheel well is
12not well founded or fully understood. The Examiner is not suggesting
13modification of the wheel well so that it extends into the passenger
14compartment as Sparling already discloses such a feature (FF 1). Instead,
15the Examiner is stating that it would have been obvious to one of skill in the
16art that the storage area of the combination of Sparling and Hawkins can be
17implemented in view of Powers to result in the invention of claim 105
18because Powers specifically shows a storage area having a width that is
19approximately the same as the width of the wheel well (Final Office Action
205; FF 5). The Examiner states the reason for providing such a combination
21is for increasing the storage volume of the vehicle (Final Office Action 5).
22We agree with the Examiner's and find that the claimed invention is merely
23a predictable variation of the storage area that is likely unpatentable. *See*

1KSR, 127 S.Ct. at 1740. Thus, the Appellants have not shown that the
2Examiner erred in rejecting claim 105.

3

4

CONCLUSION

5 On the record before us, Appellants have not shown that the Examiner
6erred in rejecting claims 49-56, 58-62, 64-73, 85, 86, 88, 89, 91, 92, 98, 99,
7101, 105, 106, 108, 109, 111 and 113 as unpatentable over the prior art of
8record.

9

10

ORDER

11 The Examiner's rejections of claims 49-56, 58-62, 64-73, 85, 86, 88,
1289, 91, 92, 98, 99, 101, 105, 106, 108, 109, 111 and 113 are AFFIRMED.

13 No time period for taking any subsequent action in connection with
14this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
15§ 1.136(a)(1)(iv) (2007).

16

17

AFFIRMED

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19 JRG

20

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